

REMARKS

In response to the Official Action mailed February 17, 2006, Applicants submit the following amendments and remarks.

As an initial matter, the Examiner has noted that the first sentence of the specification must include the correct relationship between the application and prior applications. Along this line, Applicants have amended the first sentence of the specification to thereby correctly claim priority to prior applications. No new matter has been added as a result of this amendment.

Additionally, the Examiner has requested that the lengthy specification be checked to the extent it is necessary to determine the presence of all possible minor errors. Applicants have reviewed the specification and are not aware of any minor errors.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b) — MARNAY

In the Official Action, claims 1-3, 5, 6, and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,314,477 to *Marnay*. Besides various features, the Examiner contends that it can be construed that the post of the tool is retractable when the surgeon retracts the post out of the prosthesis after insertion. In response to this rejection, Applicants have amended claim 1 to thereby more clearly claim the present invention. Specifically, newly amended claim 1 includes the recitation that the manipulation tool has a proximal end, a distal end and a post. The post includes a first position and a second position wherein when the post is disposed within the first position, the post is disposed within the distal end of the manipulation tool. But, when the post is in the second position, the post extends outwardly from the distal end of the manipulation tool. Thus, after the intervertebral spacer device is positioned using the manipulation tool, the post may be moved into the second

position and firmly housed within the distal end of the manipulation tool. The manipulation tool may then be removed from the patient without any fear that the post may inadvertently contact soft tissue or bone while the manipulation tool is being removed. No new matter has been added to the present application as a result of this amendment.

This recitation distinguishes the present invention over *Marnay* in that *Marnay* discloses rods 812, 813, 822, and 823, which extend outwardly from a positioning plier 80. Although the rods may be pivoted about a fulcrum, the rods cannot be retracted to within the positioning pliers as included within claim 1 of the present application.

Additionally, newly amended claim 1 of the present application includes the recitation that the engagement hole is placed on a perimetrical region of either the first baseplate or the second baseplate. As included within claim 1, the engagement hole is disposed within one of the baseplates and faces the other of the baseplates. This recitation also distinguishes the present invention over *Marnay* in that *Marnay* discloses a prosthesis 100, which has threaded holes 115, 116, 125 and 126, which are designed to receive the rods 812, 813, 822 and 823 of the positioning pliers 80 such that the prosthesis may be inserted. However, in contrast to the present invention, the threaded holes 115, 116, 125, and 126 of *Marnay* do not face an imposing baseplate, but rather face outwardly from the baseplate toward a direction which is 90% from the other of the baseplates. Thus, claim 1 is not anticipated by *Marnay* for the above mentioned reason and should be deemed patentable. Additionally, since claim 1 should be deemed patentable, claims 2, 3, 5, 6, and 12 based on the dependency from claim 1 should also be deemed patentable.

CLAIM REJECTION UNDER 35 U.S.C. § 102(b) — GILL

Claims 1-3, 5-9, 11 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,113,637 to Gill, et al. Similar to *Marnay*, the Examiner asserts that the posts used in conjunction with the tool disclosed in *Gill* are retractable when the surgeon retracts the post out of the prosthesis after insertion. However, as discussed above with regard to *Marnay*, the post of the manipulation tool of the present invention has a first position and a second position wherein in the first position, the posts are housed within the distal end of the manipulation tool but in the second position the post extend outwardly therefrom. As with *Marnay*, *Gill* discloses a manipulation tool, i.e., insertion tool 70 that includes screws 90 which can extend through apertures 80 of the insertion tool. The screws 90 may extend from the insertion tool, but the screws cannot be entirely housed within the distal end of the tool as included within claim 1 of the present application. Additionally, as mentioned previously, claim 1 includes a recitation wherein the engagement hole of the intervertebral spacer is placed on one of the baseplates such that the engagement hole faces the other of the baseplates. As with *Marnay*, *Gill* includes engagement holes or aperatures 58, which do not face the other of the baseplates on which they are not disposed, and since the screws or post 90 of *Gill* are limited to having a structure which is disposed along a single longitudinal axis, the screws would be unable to engage holes not facing outwardly from the device as included within the claims of the present application. Thus, claim 1 as well as dependent claims 2, 3, 5-9, 11, and 12 based on their dependency should also be deemed patentable and in condition for allowance.

35 U.S.C. § 102(b) — YOUNG

Claims 1-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,190,414 to Young et al. The Examiner is interpreting that the claimed element "engagement hole" may be a cavity in something solid or an opening and thus contends that Young discloses all of the elements of claim 1. Regardless, newly amended claim 1 as previously mentioned, includes the recitation wherein the post of the manipulation tool has a first position and a second position. The first position corresponding to a position wherein the post is disposed within the manipulation tool and the second position relating to the post extending from the manipulation tool. Young is limited to disclosing a post, i.e., a telescopic jack mechanism 138, which may be engaged with an orthopedic device. However, in contrast to claim 1 of the present application, the jack mechanism 138 does not have a first position such that the jack is disposed within the manipulation tool. Thus, even after the orthopedic device is positioned correctly and the manipulation tool is removed from the patient, the jack mechanism still extends outwardly from the tool as opposed to being confined within the tool, as included within claim 1 of the present application. Thus, Applicants assert that claim 1 is in condition for allowance and should be deemed patentable as well as claims 2-12, which depend from claim 1.

Applicants have added claims 13 and 14 to the present application. Newly added claim 13 includes the same recitation with regard to the manipulation tool having a post which has a first position and a second position. Thus, for all the arguments consistent herein, Applicants assert that claim 13 should be deemed patentable and allowed. And, claim 14 includes the recitation that the manipulation tool only includes a single engagement device that is designed to be engaged with the engagement hole of the first or second baseplates. In contrast,

Gill and *Marnay* disclose a plurality of posts or engagement devices which engage the prosthesis device to be inserted. Further, *Young* discloses an engagement device, i.e., jacking mechanism 138, wherein at least two ends of the jacking mechanism contact the orthopedic device. Although the jacking mechanism may be considered a single engagement device both a first and a second end of the jacking mechanism 138 contact the orthopedic device. Thus, Applicants assert that newly added claim 14 is also in condition for allowance.

In the Official Action, claim 1-12 were provisionally rejected on the ground of a non-statutory obviousness-type double patenting as being unpatentable over claims 1, 5-7, 12, 15, 17, and 19 of co-pending application number 10/663,492. Applicants respectfully traverse the Examiner's provisional rejection and assert that newly amended claim 1 as well as newly added claim 13 both include the limitation that the post has a first position and a second position. Neither of these recitations is included within co-pending application number 10/663,492.

Claims 1 and 2 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,896,676. The Examiner asserts that although the claims are not identical, they are not patentably distinct from each other because both claims are directed to a spinal implant that has two baseplates that are articulable and a tool with a shaft and a post used within the device. Regardless of the Examiner's assertion, newly amended claim 1 and newly added claim 13 includes recitations directed to the post having a first position, wherein the post is inserted within the tool and a second position where the post extends outwardly from the tool. Neither of these recitations is included within claim 1 of U.S. Patent No. 6,896,676. Thus, Applicants assert that claims 1 and 2 are patentably distinct

from claim 1 of U.S. Patent No. 6,896,676 as well as the remaining claims in the present application.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

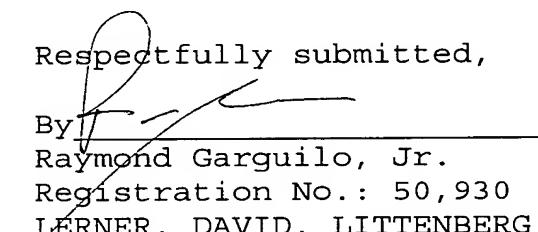
If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 2, 2006

Respectfully submitted,

By


Raymond Garguilo, Jr.
Registration No.: 50,930
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant